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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,813

02/05/2004

Kim D. Gooding

CO/2-22844/A/CGC 2143

5963

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7590

10/05/2006

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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TARRYTOWN, NY 10591-9005

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,813

Applicant(s)

GOODING ET AL.

Examiner

Kriellion A. Sanders

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6-9, 13-15 and 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 10-12 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 4, 6-9, 13-15 and 17-23 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/09/06.
2. Applicant's election with traverse of the election of species requirement in the reply filed on 1/09/06 is acknowledged. The traversal is on the ground(s) that all of the elements of the non-elected claimed invention(s) are present in the elected claimed invention. This is not found persuasive because the inventions are related as product as process of use.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's arguments with respect to claims 1-3, 5, 10-12 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 5, 10-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 01277808.

The reference is relied upon for reasons of record. The European patent is directed to a process for preparing a pigment composition comprising a) mixing a pigment and a urea-aldehyde resin and/or a urea-ketone resin in a homogenizer or in the inlet (feeding) zone of the extruder, and b) extruding the mixture obtained in step a), and to a pigment composition obtainable by the process.

Suitable organic pigments for the patented pigment composition are selected from the group consisting of azo, azomethine, methine, anthraquinone, phthalocyanine, perinone, perylene, diketopyrrolopyrrole, thioindigo, iminoisoindoline, dioxazine, iminoisoindolinone, quinacridone, flavanthrone, indanthrone, anthrapyrimidine and quinophthalone pigments, or a mixture or solid solution thereof; especially an azo, dioxazine, diketopyrrolopyrrole, quinacridone, phthalocyanine, indanthrone or iminoisoindolinone pigment, or a mixture or solid solution thereof.

These pigments include the group consisting of C.I. Pigment Red 202, C.I. Pigment Red 122, C.I. Pigment Red 179, C.I. Pigment Red 170, C.I. Pigment Red 144, C.I. Pigment Red 177, C.I. Pigment Red 254, C.I. Pigment Red 255, C.I. Pigment Red 264, C.

The ground and sieved pigment compositions for solvent paints or spread coating have a maximum particle size below 500 μm , preferably the particle size of the pigment compositions lies within the range of 100 to 500 μm .

The invention relates also to an organic or inorganic, high molecular weight or low molecular weight material, especially a high molecular weight organic material comprising the above-described compositions according to the invention in a effective amount ranging from 0.01 to 70% by weight weight, based on the organic or inorganic material.

See paragraph 0008, 0016, 0017, 0025, 0028 and 0033.

The properties of the pigments resulting from the prior art process such as the ability of the pigment granules to dissolve, are considered to be inherently provided by the correlative properties of the components used therein. Since these properties cannot be separated from their components they are necessarily present in the prior art compositions.

Response to Arguments

5. Applicant's arguments filed 7/12/06 have been fully considered but they are not persuasive. Applicant argues that the EP reference does not include a limitation to a water-based paint system having an aqueous phase, this argument is not persuasive because the patent refers to aqueous coating systems and suggests the use of the claimed urea-aldehyde pigment granules in a variety of coating compositions. Given the teachings of the reference, the ordinary practitioner in this art would have found it obvious to employ the urea-aldehyde pigment granules of the patented invention in water-based paints. See in particular, paragraph [0002] wherein patentee indicates that after being mixed into an aqueous or solvent -borne resin system, an organic pigment must be further dispersed prior to its final application in order to insure


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homogeneous dispersion in the resin system. Patentee's invention is directed towards eliminating the additional dispersion step. See paragraph [0008]. Patentee does not exclude the aqueous resin systems from the invention. Therefore, formulation of aqueous resin or coating systems utilizing the claimed urea-aldehyde pigments would have been obvious to the ordinary practitioner of this art at the time of applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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